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REMARKS

The Examiner has rejected Claims 9-11, 21-23, 33-35 and 37-43 under 35 U.S.C. 103(a) as being unpatentable over Pollack et al. (U.S. Patent No. 6,546,390) in view of Dieterman (U.S. Patent No. 6,393,464). Applicant respectfully disagrees with such rejection.

With respect to each of the independent claims, and specifically with respect to applicant's claimed "message forwarding logic operable to forward said potentially unwanted e-mail message to its addressee together with a prompt for said addressee to provide feedback as to whether or not said received e-mail message is an unwanted e-mail message" (see the same or similar, but not necessarily identical language in each of the independent claims), the Examiner has stated that Pollack "does not specifically disclose the prompt that is sent to the user with the potentially unwanted (spam) email," but that Dieterman, (Col. 5, lines 24-46) "discloses prompting an administrator for approval of a potentially unwanted e-mail message."

Applicant respectfully asserts that, in Dieterman, messages which require approval are placed in an inbox for an administrator to approve before being put in a user's inbox. Thus, since Dieterman only discloses administrator approval, Dieterman does not teach "forward[ing] said potentially unwanted e-mail message to its addressee together with a prompt for said addressee to provide feedback as to whether or not said received e-mail message is an unwanted e-mail message," as applicant specifically claims (emphasis added).

Still with respect to each of the independent claims, the Examiner has relied on the following excerpt from Pollock to make a prior art showing of applicant's claimed technique "wherein a rule associated with said e-mail filtering logic is added if a threshold of a predetermined number of votes positively identifies said potentially

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unwanted e-mail message as an unwanted e-mail message" (see the same or similar, but not necessarily identical language in each of the independent claims).

"The method may further include steps of developing message information based on the incoming message, the relevancy scores, and the profiles of the plurality of users to the plurality of users, and delivering the message information to at least some of the plurality of users. The user profiles database may include relevancy thresholds for the plurality of users, the step of developing the message information may include a step of comparing the relevancy scores to the relevancy thresholds; and the step of delivering the message information may include a step of delivering the message information only to those users whose relevancy scores satisfy the corresponding relevancy thresholds. The user profiles database may include a maximum number of users to whom the message information is to be delivered, and the step of delivering the message information may include a step of delivering the message information to no greater than the maximum number of users. The step of delivering the message information may include a step of sending the message information to the at least some of the plurality of users as an electronic mail message, or a step of updating a message display using the message information." (Col. 3, lines 51-60)

Applicant respectfully asserts that such excerpt does not even suggest any sort of "threshold of a predetermined number of votes," as applicant claims (emphasis added). In particular, Pollack only modifies a user's profile based on the user's feedback indicating either a positive or negative preference for the message information. Clearly, Pollack also fails to disclose votes, as applicant claims, but instead only discloses a user's feedback. Thus, Pollack only uses a single instance of a user's feedback in order to modify the same user's profile, and therefore does not utilize a "threshold of a predetermined number of votes [that] positively identifies said potentially unwanted e-mail message as an unwanted e-mail message," as applicant claims.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the

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claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir.1991).

Applicant thus respectfully asserts that at least the third element of the *prima facie* case of obviousness has not been met, since the prior art references, when combined, fail to teach or suggest all of the claim limitations, as noted above. A notice of allowance or a proper prior art showing of all of applicant's claim limitations, in combination with the remaining claim elements, is respectfully requested.

Applicant further notes that the prior art is also deficient with respect to the dependent claims. Just by way of example, with respect to Claim 10 et al., the Examiner has relied on Col. 6, lines 30-32 and Col. 9, line 60-Col. 10, line 19 in Pollock to make a prior art showing of applicant's claimed technique "wherein said potentially unwanted e-mail message is forwarded encapsulated within a markup language document including a hypertext markup language document capable of being displayed utilizing a network browser, the document providing voting buttons to allow said addressee to provide said feedback."

Applicant respectfully asserts that the excerpts relied on by the Examiner only disclose posting message information to a web page and "present[ing] a graphical display of the preference matrix 200 that is directly editable by the user." Clearly, only displaying a preference matrix, as in Pollock, does not even suggest that such preference matrix is displayed in association with the forwarding of the potentially unwanted e-mail message, in the context claimed by applicant. In particular, applicant specifically claims that "said potentially unwanted e-mail message is forwarded encapsulated within a markup language document including a hypertext markup language document capable of being displayed utilizing a network browser, the document providing voting buttons to allow said addressee to provide said feedback" (emphasis added).

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With respect to Claim 37, the Examiner has relied on Col. 6, lines 19-23 in Pollock to make a prior art showing of applicant's claimed technique "wherein said scoring algorithm is responsive to an addressee list of said received e-mail message." Specifically, the Examiner has stated that such excerpt in Pollock teaches that "a design allows filtering by many means including author." Applicant respectfully asserts that the excerpt relied on by the Examiner only teaches that the "message information 120 may include...the author of the incoming message." Thus, Pollock only discloses that message information that is sent to a recipient may include an author (i.e. addressor) of the associated message. Clearly, such teaching does not even suggest any sort of scoring algorithm, as applicant claims, and especially not where the "scoring algorithm is responsive to an addressee list of said received e-mail message," as claimed (emphasis added).

With respect to Claim 40, the Examiner has relied on Col. 5, lines 24-46 in Dieterman to make a prior art showing of applicant's claimed technique "wherein said prompt for said addressee to provide feedback is not forwarded with said potentially unwanted e-mail if an administrator identifies said e-mail message as being wanted." Specifically, the Examiner has stated that, in Dieterman, it "is also described how a message prompt does not always have to be sent." Applicant respectfully asserts that such excerpt only teaches that "[t]he identity of the sender of each incoming email message is compared to identities appearing on the allowed list" such that for an email where "the sender...is determined to not appear on the allowed list...[the email] is placed in the inbox for messages requiring approval" for an administrator to approve. Then, only "[i]f approval is granted...[is] the email message paced in the normal inbox."

Clearly, Dieterman teaches a situation where the approval is required by the administrator, and is never required by the addressee. Thus, Dieterman does not disclose a situation where a "prompt for said addressee to provide feedback is not forwarded with said potentially unwanted e-mail if an administrator identifies said e-mail message as being wanted," because Dieterman does not disclose any sort of "prompt for said addressee," as applicant claims (emphasis added).

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With respect to Claim 42, the Examiner has relied on Col. 3, line 61-Col. 4, line 18 and Col. 6, line 45-Col. 7, line 3 in Pollack to make a prior art showing of applicant's claimed technique "wherein said manual confirmation is not required if a predefined number of highly trusted users positively identify said potentially unwanted e-mail message as an unwanted e-mail message." Specifically, the Examiner has stated that such excerpt from Pollack teaches "a design with means for filtering based on the consensus of user feedbacks." Applicant respectfully disagrees. Specifically, such excerpts from Pollack only relate to utilizing relevancy scores to determine whether an email is relevant to a user and thus whether the email should be sent to the user. Since such excerpts in Pollack only relate to whether to send an email to a user in the first place, applicant respectfully asserts that such does not teach applicant's specific claim language, namely that a "manual confirmation is not required if a predefined number of highly trusted users positively identify said potentially unwanted e-mail message as an unwanted e-mail message" (emphasis added).

Again, since at least the third element of the *prima facie* case of obviousness has not been met, a notice of allowance or a proper prior art showing of all of the claim limitations, in the context of the remaining elements, is respectfully requested.

Thus, all of the independent claims are deemed allowable. Moreover, the remaining dependent claims are further deemed allowable, in view of their dependence on such independent claims.

In the event a telephone conversation would expedite the prosecution of this application, the Examiner may reach the undersigned at (408) 505-5100. The

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Commissioner is authorized to charge any additional fees or credit any overpayment to
Deposit Account No. 50-1351 (Order No. NAI1P445/00.174.01).

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